

Appl. No. : 09/777,420
Filed : February 6, 2001

REMARKS

Rejections under §112

The Examiner has rejected Claims 14 and 24 under 35 U.S.C. §112, second paragraph. Specifically, the Examiner states that --hose-- should be inserted after "linear" in Claim 14 and that Claim 24 is not further limiting.

In response, Applicants have amended Claim 14 to recite "the linear material" instead of "hose." Applicants have also canceled Claim 24. Accordingly, Applicants submit that Claim 14 is in condition for allowance and request the same.

Rejections under §103

The Examiner has also rejected Claims 1-25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Hall (U.S. Patent No. 2,403,277). In response, Applicants assert that the art of record does not teach each and every recited feature. Furthermore, even if the art of record could be construed to teach each of Applicants' recited features, the Examiner has still failed to provide a suggestion to combine or modify the art of record to arrive at Applicants' recited invention.

The sole reference for the rejection of Claims 1-25 and 28, Hall, does not teach each and every recited feature of the rejected claims. Specifically, the art of record does not teach *anything* regarding Applicant's facial indicia at all, to say nothing of the facial indicia's relationship to an access panel or aperture for linear material spooling. As a result, the Examiner has failed to provide teachings from the art which teach each and every recited feature. Accordingly, Applicants submit that Claims 1-23, 25 and 28 are in condition for allowance and respectfully request the same.

Even if the Examiner can provide teachings from the art which teach or suggest individual features of Applicants' recited invention, the Examiner still must provide a suggestion or motivation to modify the primary reference, Hall. This the Examiner has failed to do. Instead, the Examiner has stated that the fact "the exterior surface of the access panel has a facial indicia...would have been *an obvious matter of ornamental design choice* to a person having ordinary skill in the art based on ornamental preference, providing no new or unexpected result." Office Action at p. 2. However, this unsupported conclusion is not a substitute for the requisite specific teaching from the art. In fact, the Federal Circuit has ruled that "[o]ur case law makes

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clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 50 U.S.P.Q. 2d., 1614, 1617 (1999). Furthermore, the Court has ruled “the showing [of obviousness] must be *clear and particular*” and that “[b]road conclusory statements concerning the teaching of multiple references, standing alone, *are not ‘evidence.’*” *Id.* (*Emphasis Added*). Accordingly, Applicants submit that unsupported conclusions concerning “ornamental design” or “ornamental preferences” are likewise not specific evidence from the art of a motivation or suggestion to modify Hall.

The Federal Circuit has also established that the Examiner is not freed from the burden of providing specific evidence to support a combination/modification merely because Applicants’ recited invention can be characterized as having aesthetic components, in addition to functional components. *See generally, In re Dembiczak*. Accordingly, the Examiner cannot dismiss the recited facial indicia related features by concluding that these recited features are a mere design choice. Applicants respectfully direct the Examiner’s attention to *In re Dembiczak*, a decision overturning an obviousness rejection of claims directed to trash bags configured to resemble pumpkins with facial indicia when filled. In this case the Federal Circuit admonished the Board with the following:

[R]ather than pointing to specific information...that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the ... [two prior art] references and the claimed invention.... Nowhere does the Board *particularly identify any suggestion, teaching, or motivation to combine* the children’s art references...with the conventional trash or lawn bag references, nor does the Board make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 U.S.P.Q. 2d., 1614, 1618 (*Emphasis Added*).

Similarly, the Examiner’s unsupported conclusion that modifying Hall is merely a “design choice...based on ornamental preference” is inadequate to support an obviousness rejection.

It is important to note that in *Dembiczak*, even though the pumpkin bag’s distinguishing features included both aesthetic and functional components, the Federal Circuit nevertheless

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ruled that these components collectively rendered the invention nonobvious over art which taught every feature of the invention when combined. Namely, the Court found the pumpkin bags were non-obvious over conventional trash bags based on characteristics such as the color of the bag, the facial indicia, and the pumpkin shape when filled, all features which under the Examiner's logic would be dismissed as mere "ornamental preference."

Similarly, in the present application, Applicants recite features which are both aesthetic and functional, such as the types of facial indicia, the location of the facial indicia with respect to a functional access panel, and a functional aperture within the facial indicia. For example, Claim 1 recites an "aperture ...within said facial indicia" which is "sized to closely surround spoolable linear material...so that the linear material can be spooled onto and unspooled from the reel drum while said housing encloses the reel drum," while Claim 14 recites an aperture within said facial indicia "through which the linear material is spooled or unspooled." Claims 21 and 25 recite that the "aperture ...within said facial indicia" is "sized to closely receive spoolable linear material." The aesthetic and functional nature of the recited features are further evidenced by Claims 21 and 25 which recite that an "aperture ...within said facial indicia" is "sized to closely receive spoolable linear material." Furthermore, other features which are both aesthetic and functional in nature are recited, such as removeable (Claim 21) or detachable (Claim 25) facial indicia and/or a removeable access panel (Claim 14) decorated with facial indicia.

In finding the aforementioned recited features obvious, the Examiner has not provided the requisite specific evidence of a suggestion to modify Hall. In addition, the Examiner has failed to provide the required specific teaching(s) from the art actually teaching Applicants' recited, aesthetically functional features in the first place. In order to support an obviousness rejection, the Examiner must provide both. As the Examiner has failed to adequately support the obviousness rejection, Applicants submit that Claim 1-23, 25 and 28 are in condition for allowance and respectfully request the same.

By stating that the facial indicia provide "no new or unexpected result," the Examiner seems to confuse the nonobviousness requirement with the utility requirement. Unexpected results are only required in *rebuttal* to a prima facie showing of obviousness, which the Examiner has not provided. With respect to new results, Applicants have set forth the utility of the claimed invention in the application as filed. See, e.g., p. 7, ll. 11-12 and 19-23.

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The Examiner has also rejected Claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Hall in view of Ewald (U.S. Patent No. 2,286,904). Applicants assert that, with regard to independent Claim 25 (from which Claim 27 depends), Ewald does not provide the above-mentioned deficiencies of Hall. Accordingly, Applicants submit that Claim 27 is in condition for allowance and respectfully request the same.

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CONCLUSIONS

In view of the foregoing amendments and remarks, Applicants submit that the application is in condition for allowance and respectfully request the same. If, however, some issue remains that the Examiner feels can be addressed by Examiner's amendment, the Examiner is cordially invited to call the undersigned for authorization.

Respectfully submitted,

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